REMARKS/ARGUMENTS

Claim 3 has been canceled.

The Examiner rejected claim 3 under 35 U.S.C. § 112. Claim 3 has been canceled.

The Examiner rejected claims 1, 2, 12, 13, and 15 under 35 U.S.C. § 102(e) as being anticipated by Martineau (U.S. Patent No. 5,915,226).

Regarding claim 1, Martineau does not disclose a mobile telephone handset which is arranged to generate a request message to load a value onto the smart card. The Examiner cited col. 5, lines 18-54, as disclosing this. Col. 5, lines 18-54, discloses a handset that uses a prepaid card and a separate SIM card. However, nothing in the cited section of Martineau discloses that a request for loading a value onto the smart card is generated by the handset. Instead, the prepaid card is prepaid before it is placed in the handset. Col. 6, lines 40, to col. 7, line 29, of Martineau in col. 6, lines 40-55, states that before allowing any calls the SIM authenticates the prepaid card and then calls are allowed and the prepaid units on the prepaid card are decremented. There is no discussion of loading units onto the prepaid card over the phone by generating a message to load a value. In addition, the Examiner has failed to point out anything in Martineau that recites generating a message to load a value onto the smart card.

The Examiner also failed to point out anything in Martineau that teaches a gateway computer arranged to receive the request message from the handset over the telecommunications network and to retransmit the request message, as recited in claim 1. Although the Examiner cited co. 3, lines 23-25, and col. 4, lines 16-61, for showing this, these passages do not teach a gateway computer arranged to receive the request message from the handset over the telecommunications network. The request message is a request message to load a value onto the smart card, as recited in claim 1. Col. 3, lines 23-25, of Martineau cited by the Examiner states that a new prepayment value may be placed in the card. This passage does not state how a new prepayment is added. The card may need to be taken into a service provider to have value added. Nothing in Col. 3, lines 23-25, suggests that value is added to the card by sending a request to load value over a telecommunications network, as recited in claim 1. Similarly, nothing in col. 4, lines 16-61, of Martineau cited by the Examiner teaches adding value to the card by sending a request to load value over a telecommunications network, as recited in claim 1. Col. 4, lines 16-21, of Martineau discloses allowing the transfer of goods/services to a user of the card from a network operator by subtracting prepaid units, but does not discuss loading value on the card

over the network. The applicant did not see anything in col. 4, lines 16-61, that discloses or suggests a gateway computer arranged to receive the request to load value onto the smart card over the telecommunications network.

The Examiner also failed to specifically point out anything in Martineau that teaches a fund issuer computer arranged to receive the request message and debit a consumer account associated with the smart card and an authentication computer arranged to receive the request message and to authenticate the smart card, whereby the smart card may be authorized to load the value. Col. 2, lines 1-20, of Martineau, cited by the Examiner, describes a phone system where a removable SIM is mounted into a handset. The SIM identifies the user. When the handset is used, the user is billed for telephone services. This is not related to having a value loaded on to the SIM by generating a request to load value onto the SIM, and the transmitting the request over a network and then having a fund issuer debit an account associated to the smart card and then having an authentication computer arranged to receive the message and to authenticate the smartcard where the smart card may be authorized to load the value, as recited in claim 1. Billing an individual identified by a SIM for phone service, as disclosed in Martineau does not anticipate debiting a value to be loaded on a SIM and then authenticating the SIM to authorize the loading of the value on the SIM, as recited in claim 1.

In addition, Martineau does not disclose that the fund issuer is arranged to debit a consumer account associated with the smart card. Col. 2, lines 1-5, of Martineau disclose billing a customer, but not debiting a consumer account.

In addition, the applicant is not sure what the Examiner considers in Martineau to be the subscriber identification module and the separate smartcard. Col. 3, lines 22-43, and col. 5, lines 42-47, of Martineau identifies the smartcard as the SIM. It is this SIM card that the Examiner appears to be arguing has the value increased on. This SIM card/Smartcard where the value is increased does not provide a separate SIM card and a separate smartcard, where the value is increased on the smartcard, as recited in claim 1. For at least these reasons, claim 1 is not anticipated by Martineau.

Regarding claim 12, Martineau does not disclose a method of loading value over a telecommunications network onto a smart card, comprising receiving at a handset a request to load a value into a stored-value application of the smart card. As discussed above, regarding claim 1, although Martineau in col. 3 lines 23-25, discloses that a new prepayment value may be placed in a card, Martineau does not disclose if that is done by a handset or by providing the card

to a service operator or Automatic Teller Machine through some other method. The Examiner failed to point out and the applicant did not see anything in Martineau that discloses the handset being used to load value onto the smart card.

In addition, Martineau does not disclose the steps of generating a fund request message which includes the value and an authorization certificate, sending the funds request message over the telecommunications network to a funds issuer computer arranged to authenticate the second application and to generate an authentication response certificate; receiving through the mobile telephone handset to the smart card a response message which includes the authentication response certificate; validating the authentication response certificate; and loading the value onto the stored-value application of the smart card from the second application. The applicant found nothing in Martineau that discloses loading value into a smart card through the handset. Therefore, nothing in Martineau further discloses the use of certificates to provide value over a network from a funds issuer so that the value may be loaded onto the smart card, as recited in claim 12.

The Examiner cited col. 6, lines 4-29, of Martineau. The cited passage discusses how the SIM is programmed to only allow calls to 611. Col. 6, lines 33 to 35, of Martineau states that if credit is sought and approved, the SIM is updated over the Air, OTA, and the FDN restriction is turned off. This passage merely states that if the credit is approved, the FDN (fixed dialing number (611)) is turned off. It does not state that a fund value is loaded onto the SIM, as recited in claim 12. Instead, it simply reprograms the SIM to allow dialing of other numbers instead of a fixed 611 number. For at least these reasons, claim 12 is not anticipated by Martineau.

The Examiner rejected claims 9, 4, and 10 under 35 U.S.C. § 103(a) as being unpatentable over Martineau (USPN 5,915,226) in view of Baker et al. (USPN 5,884,292) and further in view of Joao et al. (USPN 6,529,725)

Regarding claim 9, as discussed above regarding claim 12, Martineau does not disclose receiving at a mobile handset a request from a user to load a value onto the smart card inserted in the handset; generating a funds request message which includes the value; sending the fund request message over the telecommunications network to a fund issuer computer arranged to debit an account associated with the user; sending a load request message over the telecommunications network to a funds issuer; sending the load request message over the telecommunications network to an authentication computer arranged to authenticate the smart card. As discussed above, regarding claims 1 and 12, col. 3, lines 23-43, of Martineau, cited by

the Examiner first in lines 23-25 discusses that new prepayment values may be placed on the card. Martineau does not teach doing this over a wireless telephone system. Col. 3, lines 34-37, of Martineau teaches upgrading the subscription of the SIM over the wireless network. As discussed above, such an upgrading changes the subscription to a subscription with restricted capabilities (e.g. only dialing 611) to a traditional subscription to a cellular phone, as described in col. 3, lines 33-37, of Martineau.

The abstract of Baker recites a system where a user goes to a station, such as a post office, to request adding value on a smart card. The station sends the information to a Data Center. If the Data Center sends messages to each station connected to the Data Center. When the smart card is placed in a station, then the value is added to the smart card.

Col. 12, lines 66, to col. 13, line 65, of Joao, cited by the Examiner describes a system, FIG. 1, that has a point-of-sale terminal and a wireless telephone in communication with a central processing computer. Col. 14, lines 4-51, of Joao, cited by the Examiner, further states that the point-of-sale terminal and the central computer communicate with each other and that the central computer communicates with the wireless telephone. Col. 15, lines 54, to col. 16, line 3, of Joao, cited by the Examiner, further describes how the central processing computer is able to communicate with the point-of-sale computer and the wireless telephone. Col. 16, line 57, to col. 17, line 25, of Joao, cited by the Examiner, discuses contacting the smart card with the point-of-sale terminal. Col. 19, line 8, to col. 20, line 15, of Joao, cited by the Examiner discusses that each transaction with a smart card causes the central processing computer to call up a pager or phone to obtain approval of the transaction by the user.

In addition, it would not have been obvious to combine the systems of Martineau, Baker, and Joao to obtain the invention, as recited in claim 9, which allows a wireless telephone handset to be used to increase the money value on a smart card, so that the smart card can be removed from the handset and placed in contact with a point-of-sale terminal, where the point-of-sale terminal debits the smart card to perform a purchase. The Examiner states that the motive for combining Martineau, Baker, and Joao would be to increase system flexibility.

Ex parte Clapp (227 USPQ 972) states that "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference." The Examiner failed to cite anything in the references

that expressly or impliedly suggest the combination recited in claim 9. Martineau only relates to purchase of sales or goods related to cellular phone use, not the purchase of items such as shopping.

As argued above, Martineau does not teach or suggest adding value to the smart card over the phone. Even if it could be interpreted that Martineau taught or suggested this, it would not be obvious that the same smart card could then be removed from the handset to make a purchase at a point-of-sale terminal, in view of Baker and Joao.

For at least these reasons, claim 9 is not made obvious by Martineau, in view of Baker and Joao.

The Examiner rejected claims 5, 6, and 8 under 35 U.S.C. § 103(a) as being unpatentable over Martineau (USPN 5,915,226) in view of Joao et al. (USPN 6,529,725)

Regarding claim 5, as discussed regarding claim 1, Martineau does not disclose a telephone handset arranged to generate a funds request message with an authorization request certificate. In addition, as discussed regarding claim 1, Martineau does not disclose a gateway computer arranged to receive the funds request message from the handset over the telecommunications network and to retransmit the funds request message. In addition, as discussed regarding claim 1, Martineau does not disclose a fund issuer computer arranged to receive the request message and debit a consumer account associated with the smart card. In addition, as discussed regarding claim 1, Martineau does not disclose a smartcard separate from the SIM, where the value is increased on the smartcard separate from the SIM.

As discussed above regarding claim 9, it would not be obvious to combine the card system of Martineau with the teaching of Joao of making a purchase by contacting the smartcard with a point-of-sale terminal to obtain the invention recited in claim 5. For at least these reasons, claim 5 is not made obvious by Martineau in view of Joao.

The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Martineau (USPN 5,915,226) and further in view of Joao et al. (USPN 6,529,725) and further in view of Heinonen et al. (USPN 5,887,266).

The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Martineau (USPN 5,915,226) in view of Baker et al. (USPN 5,884,292) and further in view of Joao et al. (USPN 6,529,725) and further in view of Heinonen et al. (USPN 5,887,266).

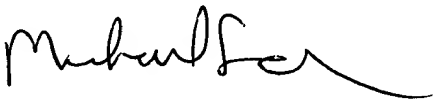
The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Martineau (USPN 5,915,226) in view of Heinonen et al. (USPN 5,887,266).

The Examiner rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Martineau (USPN 5,915,226) in view of Lucero (USPN 5,559,312). Claim 3 has been canceled.

Claims 2, 4, 6-8, 10-11, and 13-15 are directly or indirectly dependent on the independent claims, and are therefore respectfully submitted to be patentable over the art of record for at least the reasons set forth above with respect to the independent claims. Additionally, these dependent claims require additional elements that when taken in the context of the claimed invention, further patentably distinguish the art of record. For at least these reasons, claims 2, 4, 6-8, 10-11, and 13-15 are not made obvious by the cited references.

Applicants believe that all pending claims, as amended, are allowable and respectfully request a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at telephone number (831) 655-2300.

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP



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